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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,625	04/01/2004	Joseph R. Hedrick	IGT1P006C1R1	2819
22434	7590	09/13/2005	EXAMINER	
BEYER WEAVER & THOMAS LLP			LAYNO, BENJAMIN	
P.O. BOX 70250			ART UNIT	
OAKLAND, CA 94612-0250			PAPER NUMBER	
			3711	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/817,625	Applicant(s) HEDRICK ET AL.	
	Examiner Benjamin H. Layno	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-62 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 10-25 and 27 is/are allowed.
- 6) ☐ Claim(s) 26 and 28-62 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/21/05; 3/14/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 9/02/04; 5/20/04</u> . |

DETAILED ACTION

Reissue Applications

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. A statement such as "failure to include the following claims in the original patent..." is not an acceptable statement of an error. Specific changes or amendments to the claims must be identified. There must be an explanation pointing out the differences between the new claims 28-62 and the original claims. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Allowable Subject Matter

2. Claims 1-8, 10-25 and 27 are allowed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 26, 31, 32, 34-39, 41-46, 49, 53 and 56-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Miodunski et al.

The patent to Miodunski et al. discloses a gaming machine comprising a chassis 104, a gaming machine controller 122 for controlling the outcome of a primary game, a

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main display 140 presenting the outcome of the primary game, and a player tracking device 130 mounted on the chassis. The player tracking device comprises a secondary display 134 separate from the main display which is operable to display video content, and one or more interfaces (keypad) 132 designed or configured to input player tracking information (personal identification number) into the gaming machine. The player tracking device further comprises a network interface, network 106, modem 110, designed to send and to receive player tracking information over a player tracking network. A portion of the video content related to the player tracking information is displayed on the secondary display. The video content on the secondary display relates to a secondary game, which includes a bonusing component to the primary game, col. 5, lines 33-35. In regard to claims 38 and 45, Miodunski et al. inherently comprises at least one speaker for generating sound corresponding to the video content.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 30, 40 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miodunski et al.

Video displays such as flat panel cathode ray tube, LCD, plasma display, field emission display, etc. are well known in the gaming art in order to make the gaming machines more attractive to players, and therefore obvious.

7. Claims 28, 29, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miodunski et al. as applied to claim 26 above, and further in view of (Kennedy or Claypole).

The patents to Kennedy and Claypole both disclose gaming machines having two displays. In Kennedy's gaming machine a secondary display 2 is provided on the belly portion of the gaming machine, a main display portion 4 located above the belly portion. In Claypole's gaming machine a secondary display provided in a top box portion of the gaming machine, which is located above a main display portion 3 of the gaming machine. In view of such teachings, it would have been obvious to mount Miodunski's secondary display 134 in a belly portion of the gaming machine located below the main display portion 140, or mount Miodunski's secondary display 134 in a top box portion located above the main display portion 140. This modification would have made Miodunski's secondary display more conveniently viewable to the players.

8. Claims 33 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miodunski et al. as applied to claim 26 above, and further in view of Charron et al.

The patent to Charron et al. disclose a gaming machine comprising a video display 120 displaying a pay table 220. In view of such teaching, it would have been obvious to display Miodunski's pay table on the secondary display 134 in order to more conveniently make changes to the pay table.

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9. Claims 47, 48, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miodunski et al. as applied to claim 39 above, and further in view of Achmuller.

The patent to Achmuller discloses a gaming machine having a multimedia board (graphics circuit board), Fig. 8. The multimedia board comprises a video processor 886 and a generic array logic GAL device for decoding encoded video signals, col. 17, lines 36-47. In view of such teaching, it would have been obvious modify Miodunski's secondary display by incorporating a multimedia board having a video processor and a decoder device for decoding encoded video signals. This modification would have enhanced the video content on Miodunski's secondary display making the game more attractive.

Rejection, 35 U.S.C. 251, New Matter

10. Claims 26 and 28-62 are rejected under 35 USC 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

The 216' patent discloses a gaming machine having a main display 220 for presenting a primary game play and outcome information, a secondary display 219, which is a video display, for displaying secondary information, and a player tracking device 313, 518 associated with a player tracking device for displaying alpha-numeric messages associated with the player tracking function, col. 7, lines 11-13 and col. 9, lines 23-33. The 216' patent describes that alpha-numeric content from the player

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tracking display 518 may be provided on the main display 220 or secondary display 219, col. 9, lines 33-35. However, the reverse is not taught. In other words, the 216' patent fails to disclose or suggest that video content from the secondary display 219 can be provided on the player tracking display 313, 518. In fact, the 216' patent fails to teach displaying or providing any video on the player tracking display 313, 518.

In the subject reissue application, newly presented independent claims 26, 39 and 49 teach that video content from the secondary display 219 can be provided on or within the player tracking system. Thus, claims 26, 39 and 49 introduce new matter into the 216' patent for which reissue is sought.

To be specific, claims 26 and 49 are directed toward a gaming machine including a player tracking system. In each of these new claims, the player tracking system comprises a "secondary display". However, in the original 216' patent, the secondary display 219 is not part of the player tracking system. Instead, it is a feature of the gaming system, col. 8, lines 50-55. The statement that the player tracking system comprises the secondary display is new matter in the reissue application.

Claim 39 is directed toward a player tracking system per se. In claim 39, the player tracking system includes "a display operable to display video content".

Conversely, the 216' patent teaches only that the player tracking display 313, 518 presents alpha-numeric information, col. 7, lines 11-13 and col. 9, lines 23-33. As disclosed in the 216' patent, video content is presented only by the main display 220 and the secondary display 219; never on the player tracking display. Thus, the reissue

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application introduces new matter because it describes the player tracking display 313, 518 as "operable to display video content".

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 26 and 28-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was **not** described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See the new matter rejection above.

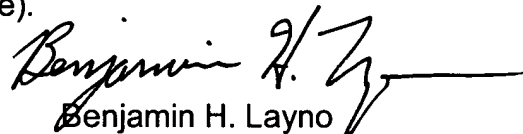
13. Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571)272-4415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin H. Layno
Primary Examiner
Art Unit 3711

bhl